

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

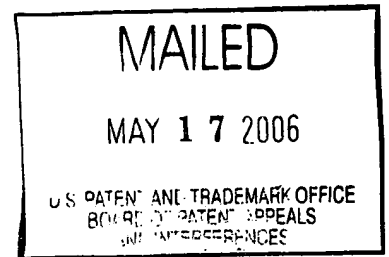
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUE SAKO

Appeal No. 2005-2660
Application No. 09/472,900

ON BRIEF



Before HAIRSTON, BLANKENSHIP, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-14.

Invention

Appellant's invention relates to a method and system to provide an electronic tender system, allowing to reduce the bidding data, and at the same time, to identify the concerned bidder even when a plurality of bidders have offered the contract price, and moreover, to keep secret the bidding information of other bidding prices than that of the successful bidder. Appellant's specification at page 3, lines 3-9.

Claim 9 is representative of the claimed invention and is reproduced as follows:

9. A method for placing a bid for a contract, comprising:
- choosing a bid price to be used in a bid;
 - obtaining a code parameter associated with the chosen bid price from a predefined set of code parameters in which a different code parameter is associated with each of respective bid prices;
 - encoding the bid using the code parameter associated with the chosen bid price in the predefined set; and
 - transmitting a message including the encoded bid to a bid receiving system.

References

The reference relied on by the Examiner is as follows:

Franklin et al. (Franklin) 6,055,518 April 25, 2000
(Filed November 12, 1996)

Rejections At Issue

Claim 9 stands rejected under 35 U.S.C. § 102 as being anticipated by Franklin.

Claims 1-8 and 10-14 stand rejected under 35 U.S.C. § 103 as being obvious over Franklin.

Throughout our opinion, we make references to the Appellant's briefs, and to the Examiner's Answer for the respective details thereof.¹

¹ Appellant filed an appeal brief on June 28, 2004. The Examiner mailed an Examiner's Answer on September 21, 2004. Appellant filed a reply brief on November 22, 2004.

OPINION

With full consideration being given to the subject matter on appeal, the Examiner's rejections and the arguments of the Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claim 9 under 35 U.S.C. § 102 and we reverse the Examiner's rejection of claims 1-8 and 10-14 under 35 U.S.C. § 103.

Appellant has indicated that for purposes of this appeal the claims stand or fall together in three groupings. See page 5 of the brief. However, the dispositive argument discussed *infra*, is applicable to all the claims. Therefore, we will consider Appellant's claims as standing or falling together, and we will treat claim 9 as a representative claim of all the claims.

It is our view, after consideration of the record before us, that the disclosure of Franklin does not fully meet the invention as recited in claim 9. Accordingly, we reverse. It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

With respect to independent claim 9, Appellant argues in the Brief and Reply that the Examiner has erred in addressing the "code parameter" limitation of the claim. We agree.

The Examiner at page 5 of the answer states, "code parameters would inherently be predefined, (such as ASCII or HTML codes)." We see no basis in Appellant's specification or elsewhere for interpreting "code parameters" to be ASCII or HTML codes. To the contrary, Appellant's specification at page 5, lines 11-16, states that the "code parameter" depends on the bidding price and the coding operation is based on the supplied "code parameter." While limitations cannot be imported into the claim from the specification, the terms of the claim must be given their appropriate meaning in light of the specification. In this situation, we find the meaning of "code parameter" is defined by the specification to be something different than ASCII or HTML codes.

Therefore, we will not sustain the Examiner's rejection under 35 U.S.C. § 102. Similarly, we will not sustain the Examiner's rejections of claims 1-8 and 10-14 under 35 U.S.C. § 103 as they rely on the same interpretation of "code parameters."

Conclusion

In view of the foregoing discussion, we have not sustained the rejection under 35 U.S.C. § 102 of claim 9; and we have not sustained the rejection under 35 U.S.C. § 103 of claims 1-8 and 10-14.

AM/gw

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